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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

~~#13~~

In re Application of
Carol A. Westbrook

Serial No. 07/784,222

Filed: October 28, 1991

For: **METHODS AND COMPOSITIONS
FOR THE DETECTION OF
CHROMOSOMAL ABERRATIONS**

§
§ Group Art Unit: 1800
§
§ Examiner: L. Bennett (Arthur)
§
§ Atty. Dkt.: ARCD:010/PAR
§
§

VIA HAND DELIVERY

**PETITION UNDER 37 C.F.R. § 1.182 or § 1.183 TO RE-COMPUTE
TIME PERIOD SUBJECT TO DISCLAIMER UNDER 37 C.F.R. § 1.137(c)**

Honorable Commissioner of
Patents and Trademarks
ATTN: Robert W. Bahr
Special Program Law Office
Washington, D.C. 20231

Sir:

This paper is filed as a Supplement to the Petition under 37 C.F.R. § 1.137(a) filed concurrently.

The above-referenced application became abandoned unavoidably. In order to effect revival of the application under 37 C.F.R. § 1.137(a), a Terminal Disclaimer that dedicates to the public a terminal part of the term of any patent granted hereon is being submitted in accordance with 37 C.F.R. § 1.137(c). As stated in the Decision on Petition mailed March 10, 1995, the terminally disclaimed period is generally computed as the number of months lapsed from the date of abandonment to the filing of a grantable petition (page 3).

An executed Terminal Disclaimer that disclaims a 27 month term of any patent that issues is being filed concurrently, the time period being suggested by Examiner Robert Bahr in an interview with Applicants' Representative, Shelley Fussey, on March 21, 1995.

The present Petition seeks review of the time period to be referenced in the Terminal Disclaimer. The Petition is being filed under the provisions of 37 C.F.R. § 1.182 or 37 C.F.R. § 1.183 and is accompanied by the \$130.00 fee required under 37 C.F.R. § 1.17(h). Specifically, Applicant requests that the portion of Rule 137(c) regarding calculation of the time period subject to the disclaimer be suspended in view of Applicant's diligent efforts to act timely during all correspondence with the P.T.O.

The application became abandoned May 16, 1992. The present Petition is being prepared March 28, 1995. If the present petition is granted, the period of abandonment will be almost three years. However, Applicants have submitted a timely response to every communication from the P.T.O. during this time, with the period for submitting the response never exceeding two months.

It appears that the intent of the Rules recited in 37 C.F.R. §§ 1.137(a) and 1.137(c) may be to hold Applicants accountable for periods of inactivity or lack of diligence. The present Applicant and representatives agree with this standard, but submit that no such periods exist in the present case. The only period of seeming inactivity on behalf of the Applicant is that between the response of August 06, 1992, and receiving the Notice of Abandonment mailed March 09, 1993. It will likely be very understandable that Applicant's Representatives believed the Application to be awaiting examination on the merits in Group Art Unit 1800 during this time.

After receiving the Notice of Abandonment, the present Applicant has acted diligently in

filings various requests and petitions, as deemed appropriate at each juncture. These actions are listed in the enclosed Chronology and a TimeLine. From the TimeLine, it will be evident that certain periods of delay have been encountered whilst the Applicant was awaiting a Decision from the P.T.O. The understanding of Examiner Bahr in already agreeing to consider a reduction in the so-called "effective period of abandonment", from about 36 months to 27 months, is noted and appreciated.

However, owing to the importance of the present application to the client, Applicant's Representatives have a professional burden to petition for further review and re-consideration of the time period. Accordingly, a further reduction is respectfully requested, particularly in light of the delay period between submitting the Petition of May 17, 1994, and receiving the Decision dated March 10, 1995. Should this prove to be acceptable to the Office, a replacement Terminal Disclaimer will be submitted.

If the Examiner has any questions or further suggestions a telephone call to Applicants' undersigned representative is most earnestly solicited.

Respectfully submitted,



Shelley P.M. Fussey
Reg. No. P-39,458

ARNOLD, WHITE & DURKEE
P. O. Box 4433
Houston, Texas 77210
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Date: March 28, 1995

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#17

In re Application of
Carol A. Westbrook

Serial No. 07/784,222

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For: METHODS AND COMPOSITIONS
FOR THE DETECTION OF
CHROMOSOMAL ABERRATIONS

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MAR 29 1995

VIA HAND DELIVERY

OFFICE OF PETITIONS
AND PATENTS

**PETITION UNDER 37 C.F.R. § 1.137(a)
TO REVIVE UNAVOIDABLY ABANDONED APPLICATION**

Honorable Commissioner of
Patents and Trademarks
ATTN: Robert W. Bahr
Special Program Law Office
Washington, D.C. 20231

Sir:

This paper is filed as a Petition under 37 C.F.R. § 1.137(a) to revive the above-referenced application that became abandoned unavoidably. This Petition is being filed promptly after receipt of a Decision on an earlier Petition, mailed from the Special Program Law Office of the P.T.O. on March 10, 1995. The present paper also constitutes a full response to the Decision of March 10, 1995, for which a two month period for response is set according to 37 C.F.R. § 1.137(d).

The proposed response required to continue prosecution of this case under 37 C.F.R. § 1.137(a)(1) is a Sequence Listing Response, which response was submitted on May 17, 1994.

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As required under 37 C.F.R. § 1.137(a)(2), a Petition Fee of \$110, as set forth in 37 C.F.R. § 1.17(l), is enclosed herewith.

The showing that the delay in prosecuting the present application was unavoidable, as required under 37 C.F.R. § 1.137(a)(3), is set forth in detail below.

In accordance with 37 C.F.R. § 1.137(c), as the present Petition is not filed within 6 months of the date of abandonment of the application, that being May 16, 1992, it is accompanied by a Terminal Disclaimer that dedicates to the public a terminal part of the term of any patent granted hereon, the terminal part being equivalent to the period of abandonment of the application. The Terminal Disclaimer applies to any patent granted on any continuing application entitled under 35 U.S.C. § 120 to the benefit of the filing date of the present application for which revival is sought. The Terminal Disclaimer is executed by an attorney of record, listed the previously submitted Power of Attorney, and is accompanied by the \$110 Fee required by 37 C.F.R. §§ 1.321(b)(4) and 1.20(d).

The Decision of March 10, 1995 states the period of abandonment should be computed as the number of months lapsed from the date of abandonment to the date of filing a grantable petition. Applicants are enclosing an executed Terminal Disclaimer that disclaims a 27 month term of any patent that issues, as suggested by Examiner Robert Bahr in an interview between Examiner Bahr and Applicants' Representative, Shelley Fussey, held March 21, 1995. Applicants request that the present Decision be first decided in light of the enclosed, executed disclaimer. However, in light of certain delays, apparently on the part of the P.T.O., Applicants request the opportunity to re-compute the period to be disclaimed and to submit a revised Terminal Disclaimer should this prove to be acceptable to the Office. This matter is the subject of another

concurrently-filed Petition.

Showing that the Delay in Prosecution was Unavoidable

On April 15, 1992, the Application Processing Division of the P.T.O. issued a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (hereafter termed 'Notice'). The Notice simply stated that a Sequence Listing, Amendment, Statement and Disk were to be submitted.

It should be noted that in April of 1992, the Sequence Requirements were still relatively new to patent prosecution. It is believed that several practitioners experienced problems in meeting the requirements of the Sequence Rules. This is supported by Figures from the P.T.O. As shown in the enclosed Sequence Response Chart prepared by the P.T.O., between 50% and 60% of certain computer-readable sequence responses filed between January and September of 1992 were in error. Although Applicants note that a computer-readable form (CRF) was not originally submitted in the present case, the enclosed Figure certainly presents evidence that those working in the area of Biotech prosecution were experiencing problems in meeting the sequence requirements during the 1992 time period.

The Sequence Notices issued at the time in question were also somewhat lacking in guidance for the Applicants and practitioners as to the nature and location of the sequences believed to be subject to the rules. The Notices now issued are more instructive in this regard, identifying the precise location of sequences or specifically indicating any previous errors. However, this was not the case in early 1992.

Therefore, upon receipt of the Notice, Applicant's Representatives began to examine the

present application to try to determine the nature and location of the sequences. The specification and claims of the present application run to 48 pages, with an additional 5 pages of drawings. With about 37 lines of text per page and about 8 or 9 words per line, this equates to very roughly about 15,000 words or other elements of text. Unfortunately, after studying the file in detail, Applicant's Representatives erred in not being able to locate one or more sequences.

It turns out that four short sequence elements are present within the specification, at pages 37 and 38. The nature of the sequences, each being only around 20 bases in length, is also believed to have contributed to the initial oversight. Again, in 1992, Applicant's Representatives had less experience in dealing with short sequences, being more used to requirements concerning sequences of literally thousands and thousands of bases, which sequences are, of course, readily identifiable.

Following the initial failure to identify sequences, Applicant's Representative contacted the P.T.O. Applications Branch and, following their instructions, later contacted Examiner Bennett to discuss the Notice in more detail. Two Declarations of Dr. Shelley Fussey, with copies of dated supporting memoranda, computer records and telephone logs, have been submitted with previous Petitions to document the conversations with Examiner Bennett. As detailed in the earlier Declarations, after reviewing the Application, Examiner Bennett informed Applicant's Representative that she was also unable to identify any sequences within the application and that she thought the original Notice was in error.

Thus, in light of the inability of four individuals with scientific training, including an Examiner with the P.T.O., to identify the referenced sequences after detailed review, Applicants submit that the failure to submit a sequence response was unavoidable.

Nonetheless, it is submitted to be clear from the record that Applicant's Representatives still made a bona fide attempt to respond in writing to the original Notice, even though informed by Examiner Bennett that she believed the Notice was improper and would be withdrawn. The original response conformed to that specified by the Examiner and was submitted via facsimile on August 6, 1992.

It appears that a copy of the August 6, 1992, facsimile response cannot be located in the P.T.O. file papers. Applicants have submitted a number of verified statements attesting to the filing of such a response, including a copy of the facsimile transmittal receipt showing that the August 6, 1992, response was transmitted to the P.T.O. on that date (Exhibit A submitted with the May 17, 1994 Petition). However, the Decision on Petition of March 10, 1995, requests that a Statement in compliance with 37 C.F.R. § 1.8(b) be submitted attesting on a personal knowledge basis to the transmission of the August 6, 1992, communication.

Applicants are pleased to provide such a Statement, which is submitted in the form of a Declaration from Thomas Northrup, the former member of Arnold, White & Durkee who originally submitted the August response. In investigating the source of the 703 557 7120 number listed on the facsimile transmittal receipt, Applicants were unable to precisely identify the former location of the machine that received the transmission. However, it will be recalled that all telephone and facsimile numbers within the 703 area code that began with the digits 557 were restricted to the P.T.O. Therefore, it is presumed that the response was received within the Office, but not assigned to the correct Application.

The various other steps taken by Applicant's Representatives since the initial Sequence Notice have been recounted in earlier Petitions, particularly the Petition of May 17, 1994, and

are not set forth again in detail. Rather, a Chronology and a TimeLine are enclosed for the convenience of the Office in reviewing Applicant's actions and attempts to restore the present case to pending status.

The TimeLine is a graphical representation of the communications between Applicants and the P.T.O. since April of 1992. This is submitted as further evidence that the Application became, and remained, abandoned unavoidably. The TimeLine shows that after receiving the Notice of Abandonment in March of 1993, a Response has been filed to every communication from the P.T.O. within a time period of two months. Thus Applicants are clearly exhibiting due diligence and making a concerted effort to progress the present case towards examination and ultimate allowance.

The fact that the Application remains abandoned to the present time is also unavoidable owing to the denial of a previous Petition to Revive for Unintentional Delay, submitted May 17, 1994. The 'Unintentional Petition' was denied because it was not timely filed under the provisions of 37 C.F.R. § 1.137(b). Specifically, the Petition was not filed within one year of the date of abandonment (May 16, 1992) or within three months of the date of a first decision on a Petition to Revive under 37 C.F.R. § 1.137(a).

As shown in the TimeLine, the first Petition directed to restoring the Application to pending status was filed on May 07, 1993, i.e., within one year of the date of abandonment. The Petition to Revive for Unintentional Delay, filed May 17, 1994, was also submitted within three months of the date of the decision on the first Petition (April 11, 1994). However, the May 07, 1993, Petition did not contain a specific reference to 37 C.F.R. § 1.137(a) as Applicant's Representatives still believed, at that time, that the holding of abandonment would be properly

withdrawn. Only after the decision of April 11, 1994, did it become apparent that sequences were indeed present within the application. Thus, the failure to file a timely second Petition under 37 C.F.R. § 1.137(b) was also unavoidable.

Applicant respectfully requests that the present Petition to Revive be granted and the case forwarded for examination on the merits.

In the alternative, Applicant requests a prompt decision on the present petition so that other avenues may still be pursued during the extensions of time available for response to the instant decision under 37 C.F.R. § 1.136(a). Applicant will next consider a Petition under 37 C.F.R. § 1.183 to suspend those portions of the rules pertaining to the time for filing a Petition under 37 C.F.R. § 1.137(b), and will submit a renewed Rule 137(b) Petition.

Should the Examiner have any questions or further suggestions a telephone call to Applicants' undersigned representative is most earnestly solicited.

Respectfully submitted,



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Date: March 28, 1995